



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/650,377      | 08/28/2003  | Carl E. Fabian       | 0018-10             | 7324             |

25901 7590 10/06/2005

ERNEST D. BUFF  
ERNEST D. BUFF AND ASSOCIATES, LLC.  
231 SOMERVILLE ROAD  
BEDMINSTER, NJ 07921

EXAMINER

ANDERSON, CATHARINE L

ART UNIT PAPER NUMBER

3761

DATE MAILED: 10/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                   |              |  |
|------------------------------|-------------------|--------------|--|
| <b>Office Action Summary</b> | Application No.   | Applicant(s) |  |
|                              | 10/650,377        | FABIAN, CARL |  |
|                              | Examiner          | Art Unit     |  |
|                              | C. Lynne Anderson | 3761         |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 6, 8-13 and 15-27 is/are rejected.
- 7) ☒ Claim(s) 4, 7 and 14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. ____   |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>11/28/03</u> .  | 6) <input type="checkbox"/> Other: ____                                     |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 8, 10-12, 16, and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Abels (4,193,405).

With respect to claims 1, 10, and 16, Abels discloses a surgical sponge system, as shown in figure 5, comprising a surgical sponge having a pocket and a flap hingedly attached, as shown in figure 5. A remotely detectable electronic marker is inserted within the pocket, as shown in figure 6, and the flap is closed and fastened by sealing the edges of the sponge, as shown in figure 7. The marker is attached to an interior surface of the sponge, as shown in figure 6.

With respect to claims 2 and 11, the pocket is in a corner of the sponge, as shown in figure 6.

With respect to claims 3 and 12, the pocket is also proximal to the edge of the sponge, as shown in figure 6.

With respect to claim 8, the flap is sewn closed, as shown in figure 7.

With respect to claim 16, the electronic marker is a radio frequency electronic marker, as disclosed in column 2, lines 33-35.

Art Unit: 3761

With respect to claim 25, the interior portion of the sponge displaced by the electronic marker comprises a well.

Claims 17-20 and 23-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Gadd (5,447,511).

Gadd discloses a surgical instrument system, as shown in figure 2, comprising a surgical instrument 10 having an aperture 30, a tag 34, and securing means 32 for securing the tag 34 to the instrument 12 at the aperture 30. The tag 34 is fully capable of being detected by electronic means, and therefore comprises an electronic tag.

With respect to claim 18, the securing means 32 is an elongated anchor, as shown in figure 2.

With respect to claim 19, the securing means 32 is attached to the tag 34, and therefore is integrally connected to the tag.

With respect to claim 20, the tag 34 has an eyelet, shown in figure 2 but not numbered, through which the anchor 32 passes.

With respect to claim 23, the securing means 32 comprises a flexible lanyard which passes through the eyelet of the tag 34 and the aperture 30 of the instrument 12, as shown in figure 2.

With respect to claim 24, the securing means 32 comprises a flexible loop, as shown in figure 2, having two ends joined to form the loop, and the tag 34 inserted through the loop.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5, 6, 13, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abels (4,193,405).

Abels discloses all aspects of the claimed invention with the exception of a staple or adhesive. Abels discloses stitching the pocket of the sponge around its perimeter, as shown in figure 5. Staples and adhesives are well-known in the art for providing suitable sealing means without the need for stitching. It would therefore be obvious to one of ordinary skill in the art at the time of invention to provide the sponge of Abels with staple or adhesive means for sealing to obviate the need for stitching the perimeter of the sponge.

Claims 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gadd (5,447,511).

Gadd discloses all aspects of the claimed invention with the exception of a rivet or screw. Gadd discloses attaching the tag to the instrument by means of an anchor, as shown in figure 2. It is well-known in the art to use rivets and screws to attach two flat, solid pieces of material such as the tag and the instrument of Gadd in order to provide a secure attachment. It would therefore be obvious to one of ordinary skill in the art at the

Art Unit: 3761

time of invention to attach the tag of Gadd to the instrument with a screw or rivet in order to provide the tag with a secure attachment to the instrument.

***Allowable Subject Matter***

Claims 4, 7, and 14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: The prior art of record fails to disclose an attachment or fastening means comprising a snap system or a hook-and-loop fastening system. Snap and hook-and-loop systems provide a releasable and resealable means of attachment. The closest prior art of record to Abels discloses a non-resealable means of attachment, stitching, and does not disclose a desire to allow for a releasable and resealable means of attachment. Therefore, the prior art of record does not teach nor fairly suggest the claimed invention.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patents 6,840,943; 6,632,228; 5,041,103; 4,658,818; 4,205,680; and 3,698,393 disclose surgical instruments having markers.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Lynne Anderson whose telephone number is (571) 272-4932. The examiner can normally be reached on Monday through Friday.

Art Unit: 3761

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tanya Zalukaeva can be reached on (571) 272-1115. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CMA  
cla

September 28, 2005

**TATYANA ZALUKAEVA**  
**SUPERVISORY PRIMARY EXAMINER**

A handwritten signature in black ink, appearing to read 'Zalukaeva', written over the printed name and title.